

### **REMARKS**

Claims 1-14, 16-45 and 47-63 are pending in this application. In light of the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this amendment, Applicant has amended the claims to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected Applicant's Rule 131 Declaration. The Examiner rejected claims 1 and 30 under 35 U.S.C. §103(a) as being unpatentable over Suzuki (USP 5,724,579) in view of Bloomfield et al. (USP 5,555,100); rejected claims 1, 3, 4, 14, 30, 32 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki (USP 5,724,579) in view of Ichihara (USP 6,977,680); and rejected claims 2 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Ichihara and further in view of Nanba (USP 6,297,870). The remainder of the claims have been rejected under 35 U.S.C. §103(a) using a variety of combinations of references. Applicant respectfully traverses these rejections

### **Preliminary Comments**

This response is being filed concurrently with a Request for Personal Interview. Prior to the Examiner's formal consideration of the arguments herein on the record, Applicant respectfully requests the Examiner contact the undersigned to schedule and conduct an interview in accordance with the request to discuss the arguments presented herein.

### **Rule 131 Declaration**

In the last response, Applicant submitted a Rule 131 Declaration asserting the invention was made prior to the effective date of Ichihara. In response to this submission, the Examiner asserts as follows:

MPEP 2138.06 [R-1] states under “diligence required in preparing and filing patent application” that six days to execute and file application is acceptable...In this case, since the time between Exhibit C dated March 8, 2000 and Exhibit D dated April 11, 2000 is more than six days, there is lack of diligence. Therefore the rejection with regards to Ichihara would be maintained.

Applicant respectfully submits that the Examiner is completely mischaracterizing Applicant’s duty for establishing diligence.

The Examiner appears to require diligence from March 8, 2000, the date the inventor’s attorney was instructed to prepare the application, to April 11, 2000, the date the inventor’s attorney was instructed to file the application. However this requirement is wholly inconsistent with the proper requirement for diligence.

Manual of Patent Examining Procedure (MPEP) §2138.06 recites as follows:

The critical period for diligence for a first conceiver but second reducer begins **not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice** and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) (“lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts”). (emphasis added)

As such, the operative period for determining diligence is just prior to **March 27, 2000 (the effective date of filing of the Ishihara application) to April 13, 2000**, not March 8, 2000 to April 13, 2000, as asserted by the Examiner.

Further, the Examiner asserts that because more than six days elapsed during his erroneously identified diligence period, that the Declaration is, *per se*, insufficient. However, the Examiner is misstating the facts set forth herein.

Applicant’s Declaration states that on March 8, 2000, he instructed his attorney to **prepare a draft patent application**. However, the case cited by the Examiner states that six days for an inventor to **execute and file** the application is acceptable. Clearly, preparing an application cannot be equated with the same time period for executing (signing) and filing an

application and the Examiner's interpretation of such is wholly inconsistent with the decision of that court. Still further, it is wholly improper for the Examiner to require that Applicant **prepare** and file an application within six days. In addition, this requirement is wholly unsubstantiated by any rule of law.

Further, courts have held that sixteen days between the completion of the drawings and specification and the applicant's review and execution of the application was reasonable. The CCPA noted that it was necessary to inspect the drawings against the specification, that the patent attorney needed to transmit the patent application to the applicant, and that the attorney did not suspend work on the patent application in favor of any later-filed case. See *Walker v. Bailey*, 245 F.2d 486 (CCPA, 1957).

Based on the above, Applicant submits the Examiner's reasons for rejecting the Declaration are wholly improper, are inconsistent with the proper requirements to establishing diligence, and completely contrary to case law.

### **Claim Rejections – 35 U.S.C. §103 – Suzuki/Bloomfield**

At the outset, Applicant submits that the Examiner's rejection is unclear. On page 3 of the Official Action, the Examiner rejects claim 1 based on the teachings of Suzuki and Bloomfield. However, in providing his required rationale in support of his rejection on page 4, the Examiner asserts as follows:

Therefore taking the combined teachings of Suzuki and Bloomfield, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have the deleted the image file in the storage medium after the communication device transmits the image file data and keeps the reduced image data of the image file in the system of **Ichihara** as taught in Bloomfield in order to only store the reduced image (thumbnail) in the memory of **Ichihara** so that the memory capacity can be efficiently used for taking next photograph by only storing a reduced version of the original image that has been already transmitted thereby not missing a photographic opportunity.

Applicant cannot understand the Examiner's references to Ichihara. The Examiner does not assert Ichihara against the claims in his rejection and does not rely on the teachings of

Ichihara to support the purported teachings of the claim elements. As such, the Examiner's reference to a modification of Ichihara is wholly improper.

Applicant cannot discern the merits of the Examiner's rejection as Applicant cannot discern whether the Examiner is modifying the teachings of Suzuki or the teachings of Ichihara.

Applicant respectfully requests clarification to the rejection in a new, non-final Official Action so that Applicant may have a proper opportunity to respond.

In addition to the above argument, in support of the Examiner's rejection of claim 1, the Examiner asserts that Suzuki discloses all of the claim elements, except the information processing device deleting from the image file in the storage medium the subject main image data after the communication device transmits the image file and keeps the reduced image data of the image file after the subject main image data is deleted. The Examiner relies on the teachings of Bloomfield to cure the deficiencies of the teachings of Suzuki, citing to col. 75, lines 47-56. Applicant disagrees with the Examiner's characterization of at least the Bloomfield reference.

The disclosure of Bloomfield is directed to a facsimile store and forward system with local interface translating DTMF signals into store and forward system commands. At col. 75, lines 47-56, Bloomfield discloses as follows:

If the transmission was not successful, the process ends in step 2446 after which the caller is free to call and try again. Otherwise, the stored facsimile information which was transmitted to the caller is deleted from the appropriate database in step 2448, a delivery report is created in step 2450 including the job ID, **a reduced image of the first page of the transmitted facsimile information**, the delivery time, etc, and operation is directed to a delivery report send subroutine in FIG. 96, discussed in detail below, where delivery of the delivery report is scheduled, after which operation ends in step 2446. (emphasis added)

However, claim 1 clearly requires the information processing device deleting from the image file in the storage medium the subject main image data after the communication device transmits the image file and **keeps the reduced image data of the image file** after the subject

main image data is deleted. Bloomberg merely keeps a reduced copy of only the first page of the facsimile transmission. Applicant submits that this teaching is insufficient to teach keeping the reduced image data of the image file after the subject main image data is deleted.

By this amendment, Applicant has amended claim 1 to recite an image data transmitting device, comprising an information processing device that creates a reduced image data ~~based on~~from a subject main image data by reducing the subject main image data, and stores an image file including the subject main image data and the reduced image data in a storage medium.

By this amendment, it is clear that all of the subject main image data is reduced in order to create the reduced image data. None of the cited references, either alone or in combination, teach or suggest this claim element, in combination with the other elements recited in the claim.

Applicant respectfully submits that claim 1, together with claims dependent thereon, are not obvious over the references as cited by the Examiner as the Examiner has failed to establish prima facie obviousness for the reasons noted above. It is respectfully requested that the outstanding rejection be withdrawn. Further, claim 30 recites similar elements and thus claim 30, together with claims dependent thereon, are not obvious over the references as cited for the reasons set forth above.

### **Claim Rejections – 35 U.S.C. §103**

With regard to the remaining rejections, Applicant submits that for the reasons noted above with regard to Applicant's Declaration, Ichihara is not proper prior art with respect to the present application and thus, the remaining rejections should be withdrawn.

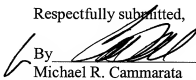
### **Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin Reg. No. 52,327 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By   
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